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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,682	01/31/2001	Jeremy Burr	INTL-0456-US (P9810)	8497

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EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/773,682		BURR, JEREMY	
	Examiner		Art Unit	
	Philip B. Tran		2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Notice to Applicant

1. This communication is in response to Supplemental Affidavit filed 03 August 2006. Claims 53-72 are pending for further examination.

37 CFR 1.131 Affidavit

2. The supplemental affidavit filed on 03 August 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Gatz et al reference (US 2002/0049806 A1) for the following reasons:

The affidavit includes exhibit, thereby alleging conception, diligence, and reduction to practice of the instant invention prior to the filing date of the Gatz reference.

(A) The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Gatz reference.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See **Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897)**.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. **Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883)**. Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy **37 CFR**

1.131. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. **In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974)**. Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. **505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964)** (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

However, the examiner respectfully submits that it is not clear how the exhibit teach applicant's claimed invention because it shows a vague idea and thus lacks support in the submitted evidence to establish a conception of the claimed invention.

(B) The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Gatz reference to either a constructive reduction to practice or an actual reduction to practice.

What is meant by diligence is brought out in **Christie v. Seybold, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893)**. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack

of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See **In re Nelson**, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See **MPEP § 2138.06** for a detailed discussion of the diligence requirement for proving prior invention. Under **37 CFR 1.131**, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under **37 CFR 1.131**. See **Ex parte Merz**, 75 USPQ 296 (Bd. App. 1947).

An applicant must account for the entire period during which diligence is required. **Gould v. Schawlow**, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); **In re Harry**, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. **In re Mulder**, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); **Fitzgerald v. Arbib**, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959)

(Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice).

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. **Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889).** Rather, applicant must show evidence of facts establishing diligence.

However, the examiner respectfully submits that it is not clear how the exhibit teach applicant's claimed invention. There is no discussion of claims as they relate to the evidence (exhibits) provided (i.e., each of the independent claims) and how the limitations of those claims find support in the evidence provided. Applicant has not provided any evidence to indicate that the invention was actually reduced to practice. Applicant must then show due diligence from before the Gatz reference until an actual reduction to practice or constructive reduction to practice. In this case, applicant has failed to provide this evidence to establish diligence from a date prior to the date of reduction to practice of the Gatz reference to either a constructive reduction to practice or an actual reduction to practice.

In addition, evidence provided is insufficient because text is so small that some exhibits are either totally or partially unreadable. For example, some portions of exhibits are blurry or blackout (see Section 3, Page 4 of the attached Exhibit).

Thus, the affidavit filed on 03 August 2006 is deemed insufficient to remove Gatz reference as prior art.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 53-57 and 61-71 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gatz et al (Hereafter, Gatz), U.S. Pat. Application Pub. No. US 2002/0049806 A1.

Regarding claim 53, Gatz teaches an apparatus comprising: a wireless communication device (= wireless communication) [see Paragraphs [0039, 0051]] and having a restricted list of contacts wherein the wireless communication device is limited to communicate with only the contacts associated with the restricted list, and wherein the restricted contact list is determined by an administrator and set by a different device (= parent control list restricts contact list that a child can have) [see Abstract and Paragraphs [0053, 0069, 0073-0080]].

Regarding claim 54, Gatz further teaches the apparatus of claim 53 wherein the wireless communication device is configured to communicate using text messaging [see Paragraphs [0013, 0061]].

Regarding claim 55, Gatz further teaches the apparatus of claim 54 wherein the text messaging comprises instant messaging [see Paragraphs [0014, 0071, 0080]].

Regarding claim 56, Gatz further teaches the apparatus of claim 53 wherein the wireless communication device is adapted to communicate using a telephone communication media [see Paragraphs [0051, 0086]].

Regarding claim 57, Gatz further teaches the apparatus of claim 53 wherein the different device comprises a personal computer connected to a network [see Paragraph [0051]].

Regarding claim 61, Gatz further teaches apparatus of claim 53 wherein the restricted list is maintained on a local memory of the wireless communication device [see Paragraphs [0052, Page 9 left Column]].

Regarding claim 62, Gatz further teaches the apparatus of claim 53 wherein the restricted list is maintained on the different device and downloaded to the wireless communication device [see Paragraphs [0053, 0069, 0073-0080]].

Claim 63 is rejected under the same rationale set forth above to claim 53.

Regarding claim 64, Gatz further teaches the article of claim 63 including instructions causing the processor-based system to create the restricted list of contacts based on an administrator's input, and download the restricted list to the wireless device [see Paragraphs [0053, 0069, 0073-0080]].

Regarding claim 65, Gatz further teaches the article of claim 63 wherein the tangible medium comprises a memory in the wireless device [see Paragraphs [0052, Page 9 left Column]].

Claim 66 is rejected under the same rationale set forth above to claim 61.

Regarding claim 67, Gatz further teaches the article of claim 63 wherein the communication media comprises, in part, the Internet [see Paragraphs [0014, 0044, 0049, 0081, 0087]].

Regarding claim 68, Gatz further teaches the article of claim 63 wherein the wireless device comprises a telephone [see Paragraphs [0051, 0086]].

Claim 69 is rejected under the same rationale set forth above to claim 53.

Claim 70 is rejected under the same rationale set forth above to claim 60.

Regarding claim 71, Gatz further teaches the system of claim 70 wherein the restricted list may be created and modified via the personal computer [see Paragraph [0051]].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 58-60 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatz et al (Hereafter, Gatz), U.S. Pat. Application Pub. No. US 2002/0049806 A1.

Regarding claims 58-60 and 72, Gatz does not explicitly teach the wireless communication device includes a transceiver to facilitate communications with contacts on the restricted list via a base station and wherein the base station comprises a local wireless router and wherein the base station comprises a transceiver coupled to a personal computer and a plurality of wireless communication devices operative to communicate with the base station, and a respective restricted list associated with each of the wireless communication devices. However, It would have been obvious to one skilled in the art to realize that a wireless device should include a transceiver to communicate with other devices (personal computers, telephones, routers, etc) [see Gatz, Paragraph [0051]] via a base station such as a tower.

Response to Arguments

7. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

The examiner respectfully submits that it is not clear how the exhibit teach applicant's claimed invention. There is no discussion of claims as they relate to the evidence (exhibits) provided (i.e., each of the independent claims) and how the limitations of those claims find support in the evidence provided. Applicant has failed to provide this evidence to establish diligence from a date prior to the date of reduction to practice of the Gatz reference to either a constructive reduction to practice or an actual reduction to practice (Attached Exhibit shows the date of 19 January 2001). Thus, the affidavit filed on 03 August 2006 is deemed insufficient to remove Gatz reference as prior art (effective priority date as of 16 May 2000).

*In response to applicant's arguments that cited reference teaches away from the invention of the instant application, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. **Colman v. Kimberly-Clark Corp., 218 USPO 789.***

Gatz teaches an apparatus comprising a wireless communication device. For example, Gatz discloses a wireless communication device [see Paragraphs 0039 &

0051]. In addition, Gatz further teaches a restricted list of contacts wherein the wireless communication device is limited to communicate with only the contacts associated with the restricted list, and wherein the restricted contact list is determined by an administrator and set by a different device. For example, Gatz further discloses a parent control list restricts contact list that a child can have [see Abstract and Paragraphs 0053 & 0069 & 0073-0080].

Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter broadly recited in independent claims. Dependent claims are also rejected at least by virtue of dependency on independent claims and by other reasons shown above. Accordingly, claims 53-72 are respectfully rejected.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip Tran

Philip B. Tran
Primary Examiner
Art Unit 2155
October 27, 2006